

REMARKS

Claims 1-5 and 7-21 are pending. Upon entry of this Reply, the amendments submitted in the After Final Reply, filed April 27, 2006 will have been entered. Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections. Applicant submits that the application is now in condition for allowance. Since all of the pending claims are in condition for allowance, the Applicant requests allowance of claims 1-5 and 7-21, and forwarding of the application to issuance.

In the Advisory Office Action mailed May 30, 2006, the Examiner refused to enter the Reply filed after Final Office Action, filed April 27, 2006. The Examiner essentially restated a portion of the reasons provided in the Final Office Action. The Examiner stated that the "Office maintains that Marucci (6,582,451) discloses jaws/manipulation members (12) comprising (inferring that it potentially includes other elements) electrodes, as well as pivoting about a shaft (28). Also, the . . . Office is confused as to how "leads" can transmit manual motion. The term "lead" strongly infers the presence of electricity. How can a lead transmit manual motion?" In response to Examiner's position and question, Applicant submits that the below provided discussion should address and refute both issues raised by the Examiner.

Initially, Applicant respectfully points out that the mere fact that something conducts electricity does not by any means preclude it from also transmitting motion. That is, physical manipulation of leads causes them to transmit motion, even though the same leads are also capable of transmitting electricity.

Applicant respectfully submits that the Examiner has failed to establish a prima facie case under either Section 103 or 112 of Title 35 of the United States Code, in the

above noted Final Office Action for at least the reasons provided below. Applicant submits that Marucci *et al.* do not teach or suggest, alone or in any proper combination, the claimed subject matter of claims 1-5 and 7-21. Applicant further submits that claims meet the requirements of 35 U.S.C. § 112, first and second paragraphs. Thus, Applicant respectfully requests reconsideration and withdrawal of the same and allowance of the application, including all pending claims.

In the above noted Final Office Action, the Examiner has rejected claims 18 and 21 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner appears to posit that "powered movement of the members" is new matter. Applicant respectfully traverses this rejection.

Applicant submits that, for example, paragraphs [0033], [0034] and [0068] *inter alia* provide support for an embodiment of the claim recitation, i.e., "wherein said manipulation members are moved between opened and closed positions via leads connected to said high frequency power supply." Thus, a written description, as originally filed, is provided for the claimed subject matter, demonstrating that Applicant was in possession of the claimed invention. Applicant respectfully requests reconsideration and withdrawal of the rejection.

The Examiner has rejected claims 16 and 17 under 35 U.S.C. § 112, second paragraph, as being indefinite. The undersigned notes that the metes and bounds of the claimed subject matter of claims 16 and 17 is clear. However, to expedite prosecution, the undersigned has amended claim 16 to more clearly define Applicant's claimed subject matter (via the Reply filed April 27, 2006), which will have been entered concurrently with the filing of this Request for Continued Examination. However, this

amendment does not affect the scope of claim coverage, but merely serves to correct asserted informalities. Thus, Applicant respectfully requests reconsideration and withdrawal of the rejection.

The Examiner has rejected claims 1-5, 7, 9, 10, 11, 13-15 and 19-20, under 35 U.S.C. §103(a), as being unpatentable over Marucci *et al.* (U.S. Patent No. 6,582,451) alone. The Applicant traverses this rejection and requests reconsideration, withdrawal of the rejection, and allowance of Applicant's application for patent.

As noted in Applicant's prior Response, filed September 22, 2005, the Office Action appears to have misconstrued the Marucci *et al.* patent, and resultantly misapplied it to the claimed subject matter. In addressing Applicant's claimed subject matter, the Office Action relies on column 6, lines 33-40 of Marucci *et al.* However, this portion of Marucci *et al.* does not teach, disclose, or render obvious the features recited in Applicant's claim 1. In particular, Marucci *et al.* disclose that in one embodiment, "the jaw members may act as platforms for diagnostic or therapeutic modalities including but not limited to: ultrasound, lithotripsy, radiotherapy, radiofrequency, unipolar/bipolar electrocautery".

The Applicant respectfully resubmits that there is a significant difference between the manipulation members comprising a pair of electrodes and the jaws acting as "platforms" for these various therapeutic modalities. Applicant's claimed subject matter is not reciting that the manipulation members are platforms (i.e., supports) for electrodes, but rather that the manipulation members comprise electrodes. The mere fact that the reference teaches that the jaws are platforms for various modalities does

not necessarily mean that the jaws are that modality. On the contrary, it might well imply that the jaws are not the modality but merely supporting such.

Moreover, the Office Action as written contradicts itself. Specifically, the Office Action attempts to equate Marucci *et al.*'s connecting member 24 and 25 to the claimed spacer, and Marucci *et al.*'s jaw structure 12 to Applicant's claimed pair of manipulation members. The interpretation of Marucci *et al.* set forth in the Office Action is incorrect because it proposes that the jaw structure 12 may have a pair of manipulation members that include electrodes, while at the same time electrically insulating connecting members 24 and 25. The Applicant submits that if the connecting members 24 and 25 are insulated, as proposed by the Office Action, then the entire jaw structure 12 would also be insulated as is clear from Fig. 1a (the jaw members 15a and 15b would be conductively isolated by the supporting members 24 and 25 from the rest of the Marucci *et al.* assembly, under the asserted interpretation). Thus, the jaw members 15a and 15b could not function as electrodes. Hence, it is clear that the Office Action has misconstrued the Marucci *et al.* patent and its teachings.

Accordingly, the Applicant again submits that there is no disclosure or teaching of this explicitly recited feature (in the claimed combination) in Marucci *et al.* Accordingly, for this reason alone, it is respectfully resubmitted that claim 1 is clearly patentable over Marucci *et al.*

Independently of the above, Applicant's claim 1 further recites that the spacer insulates the electrodes from each other. There is additionally no teaching or disclosure of this feature in the relied upon Marucci *et al.* reference. In this regard, as Applicant noted above, Marucci *et al.* merely discloses that the electrodes can be platforms for a

therapeutic modality such as electrocautery. However, because according to the teachings of Marucci *et al.*, the jaws (or manipulation members) are not the electrodes, there is no reason whatsoever for the spacer (which the Examiner reads on the linkage 24, 25) to comprise an insulating material. In direct contrast, since in Applicant's invention, the manipulation members comprise the electrodes, the spacer must insulate them from each other in order to avoid short circuiting the manipulation members.

In this regard Applicant notes the Office Action's reliance on column 12, lines 36-41 regarding the use of various plastics. However, because of the recited features of Applicant's invention, the spacer must be an insulator while the electrodes must be conductive. The cited portion of Marucci *et al.* merely indicates that the various components of the device may be formed of appropriate materials including stainless steel, atraumatic plastic, or one of various alloys. Further, Marucci *et al.* disclose that, in the alternative, "the device may be manufactured such that each component is made up of a different material to the others". However, such a broad disclosure is merely an invitation to one of ordinary skill in the art to invent and is not a disclosure that anticipates or renders unpatentable the specific recited features of Applicant's invention.

Independently of the above, claim 1 recites the manipulation members are "pivotally" supported by said shaft. However, in Marucci *et al.*, the jaws do not pivot about the shaft (28 according to the Office Action) but move parallel to each other via the parallelogram linkage 24, 25. In an attempt to read the reference on Applicant's claimed subject matter, the Office Action asserts "that the jaws (12) in fig. 1e (open position) and then fig. 1g (closed position) do indeed pivot around the shaft (28) *through linkage 25.*" See page 9 of the above noted Office Action. However, what these

illustrations show is that the jaws 12 move with the same angle of approach with respect to each other and with respect to the shaft (28 according to the Office Action), but do not pivot as required. The jaws may pivot with respect to various links but their angular orientation with respect to the shaft is constant and thus they do not pivot thereabout as can be seen by a comparison of figures 1e and 1g.

With respect to claim 19, the Office Action presents the argument that members 24 and 25 in Marucci *et al.* are fixedly positioned with respect to the support 11. The Applicant respectfully disagrees. This is correct as supporting members 24 and 25 pivot and move with respect to support 11 and are therefore not fixedly positioned. Accordingly, it is respectfully submitted that claim 19 is clearly patentable over the Marucci *et al.* reference relied upon by the Office Action. An action to such effect is respectfully requested in due course.

The Examiner has rejected claims 8 and 12, under 35 U.S.C. §103(a), as being unpatentable over Marucci *et al.* (U.S. Patent No. 6,582,451) in view of Mayenberger (U.S. Patent No. 5,853,412). The Applicant traverses this rejection and requests reconsideration, withdrawal of the rejection, and allowance of Applicant's application for patent.

The Applicant respectfully submits that this rejection is improper for at least the reasons discussed above with respect to claim 1. The Applicant further submits that the members 24, 25 (as proposed by the Office Action) are not insulating, and therefore there would have been no reason to make them from ceramic in Marucci *et al.* as proposed by the Office Action.

On a further note, it appears that the Office Action has misapplied the teachings of the MPEP 2111.03 in this case. First, Applicant notes that the MPEP is not binding law, but a guidebook to be followed by patent examiners in performing their daily functions. That having been said, MPEP Section 2111.03 instructs patent examiners that they should read transitional terms, such as “comprising,” in **claimed subject matter** as open-ended, inclusive terms. Here, the Office Action appears to misapply this guidance and interpret it as an instruction to the Examiner to interpret the **reference** as an open-ended, inclusive reference to which one may add subject matter as he or she so chooses. This interpretation of the MPEP is clearly erroneous.

Next, the Office Action appears to have misapplied the letter of the law, *i.e.* 35 U.S.C. §103, and the relevant case law. It appears that the Office Action equates broad disclosure language in the Marucci *et al.* patent as a license to the Examiner to modify the reference in any manner he so chooses, with a total disregard for the requirements established by the Supreme Court in *Graham v. John Deere*, for example. This is clearly erroneous. What the Office Action fails to appreciate is that the burden of presenting a *prima facie* case of obviousness falls on the Office. And, the Office has not met its burden.

For each of the above reasons and certainly for all of the above reasons, it is respectfully submitted that claim 1 is clearly patentable over the Marucci *et al.* reference relied upon by the Examiner in the outstanding Official Action.

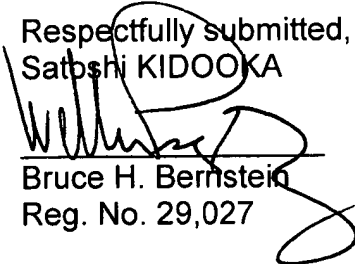
SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has pointed out support in the specification for the claimed subject matter, as well as pointed out the definitiveness and clarity of the claimed subject matter. Applicant has pointed out the significant and substantial shortcomings of the references relied upon by the Examiner with respect to the pending claims. Applicant has further discussed the explicitly recited features of Applicant's claims and has noted the shortcomings of the relied upon references with respect thereto. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all the claims in the present application and respectfully requests an indication to such effect in due course.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Satoshi KIDOOKA


Bruce H. Bernstein
Reg. No. 29,027

William Pieprz
Reg. No. 33,630

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GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191